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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,860	12/15/2005	Eiko Yoshino	04783/030001	2352

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OSHA LIANG L.L.P.
TWO HOUSTON CENTER
909 FANNIN, SUITE 3500
HOUSTON, TX 77010

EXAMINER

VANCHY JR, MICHAEL J

ART UNIT	PAPER NUMBER
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2624

NOTIFICATION DATE	DELIVERY MODE
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12/11/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com
buta@oshaliang.com

Office Action Summary	Application No. 10/560,860	Applicant(s) YOSHINO, EIKO	
	Examiner MICHAEL VANCHY JR	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/23/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A Request for Continued Examination has been received on October 14, 2008.
2. Claims 1, 6, 7, and 13-15 have been amended.
3. Claims 16 and 17 have been added.
4. Claims 3-5 have been stated to be canceled in the Applicant's Arguments on October 14, 2008, however the presented amendments to the claims filed on the same date do not show the claims as being canceled. Thus the previous rejection is still within this office action. Please make appropriate correction if/where required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luman et al., 7,129,934 B2 and further in view of Kashiwagi et al., US 6,396,598 B1.

Regarding claim 1:

Luman et al. (Luman) uses a plurality of touch-sensitive input/display tablets (terminal devices), which can include a predetermined drawing (background) that multiple users can mark up, with hand drawn markings, on the touch-sensitive tablets (col. 3, lines 7-21). These mark ups are placed on and around the drawing, which can be displayed back onto the tablets as well as being displayed through a projection means or CPU (Fig. 1). The tablet can receive input data through the wireless communication link (col. 5, lines 63-67).

Luman teaches a printer (Fig. 1 item "110") along with a computer which is configured to receive image information and to manipulate the image drawings such as, but not limited to, expanding or contracting a background image (col. 4, line 61 to col. 5 line 7). Luman teaches a storage unit that stores coordinate data, a display device, and a central processing unit which causes the display device to display the content of the handwritten notes superimposed on the background image (Fig. 3, col. 3, lines 7-21, col. 6, lines 45-61).

Luman teaches a plurality of terminal devices which are touch-sensitive however Luman is silent on using a "paper medium." Kashiwagi teaches an apparatus for electronic memo processing. As stated by Kashiwagi, the memo can be electronic or a paper document (Fig. 1, col. 1, lines 10-17 and col. 10, lines 39-56). It would be clear to one of ordinary skill in the art to modify Luman at the time of the invention to include a paper medium being placed upon a handwritten input device, to allow for a paper copy to also be available. The examiner takes into account that the prior art used in the previous action fully encompasses the claim limitations taken as a broad interpretation of the claim language. Since Luman has a printing function which can manipulate a

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drawing (including a background drawing) and that a computer can already have a "pre-existing image" for mark-up (col. 3, lines 7-21), the background image can easily be printed and placed upon (or in) the tablet (handwritten input device) for marking with handwritten notes by a user.

Regarding claim 2:

Luman teaches the tablets (terminal devices) can receive the background image data through wireless communication links (communication circuit), for example RF (col. 3, lines 42-46).

Regarding claim 3:

Luman teaches the terminal device according to claim 1, further comprising printing control means (Fig. 1, item "108" a computer for control means) for printing the background image on the medium in a printing device in accordance with the background image data (Fig. 1, item "110" and col. 4, lines 30-38).

Kashiwagi teaches an apparatus for electronic memo processing. As stated by Kashiwagi, the memo can be electronic or a paper document (Fig. 1, col. 1, lines 10-17 and col. 10, lines 39-56). The examiner would also like to point out that since the tablets in Luman are touch-sensitive, placing a piece of paper on top of the tablet would result in a paper copy and electronic copy being created.

Regarding claim 4:

Luman teaches the terminal device according to claim 3, wherein the printing control means (Fig. 1 computer "108") causes the printing device (Fig. 1 printer "110") to print the background image expanded or contracted in at least one direction (manipulate the drawings/markup images), in accordance with the region where the medium is placed in the handwriting input device (col. 4, line 61 to col. 5, line 7).

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Kashiwagi teaches an apparatus for electronic memo processing. As stated by Kashiwagi, the memo can be electronic or a paper document (Fig. 1, col. 1, lines 10-17 and col. 10, lines 39-56). The examiner would also like to point out that since the tablets in Luman are touch-sensitive, placing a piece of paper on top of the tablet would result in a paper copy and electronic copy being created.

Regarding claim 5:

Luman teaches the terminal device according to claim 4, further comprising storage means (Fig. 3, items "329 and 330") that stores co-ordinate data whereby a correspondence is established between co-ordinates in the printing region in which the background image is printed on the medium and co-ordinates in a display region in which the background image is displayed by the display means, wherein the reproduction means displays the content of the handwritten notes superimposed on the displayed background image in accordance with the co-ordinate data (col. 5, lines 57-67).

Kashiwagi teaches an apparatus for electronic memo processing. As stated by Kashiwagi, the memo can be electronic or a paper document (Fig. 1, col. 1, lines 10-17 and col. 10, lines 39-56). The examiner would also like to point out that since the tablets in Luman are touch-sensitive, placing a piece of paper on top of the tablet would result in a paper copy and electronic copy being created.

Regarding claim 6:

Luman teaches the terminal device according to claim 1, wherein the printing control means (Fig. 1 computer "108") expands or contracts the background image in at least one direction in accordance with the region, on the medium, that is printable (manipulate the drawings/markup images) by the printing device (col. 4, line 61 to col. 5, line 7).

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Regarding claim 7:

Luman teaches the terminal device according to claim 1, wherein the printing control means further causes the printing device to print a reference mark indicating the direction for placing the medium on the handwriting input device (Fig. 2, items “108 and 110” col. 4, lines 49-60, The examiner takes into account that a reference mark can easily be implemented through different “program modules” from the computer to “manipulate the drawings/markup images,” discussed by Luman.).

Kashiwagi teaches an apparatus for electronic memo processing. As stated by Kashiwagi, the memo can be electronic or a paper document (Fig. 1, col. 1, lines 10-17 and col. 10, lines 39-56). The examiner would also like to point out that since the tablets in Luman are touch-sensitive, placing a piece of paper on top of the tablet would result in a paper copy and electronic copy being created.

Regarding claim 8:

Luman teaches the display system comprising: a first terminal device and a second terminal device constituting terminal devices according to claim 1 (Fig. 2); and a server connected through a communication circuit with the first terminal device and the second terminal device (Fig. 2, items “102 and 108” The examiner takes into account that the projector and computer work as servers in Luman’s system.), wherein the first terminal device sends the background image data to the server through the communication circuit (col. 3, lines 11-14), the server sends the background image data received from the first terminal device to the second terminal device through the communication circuit, and the second terminal device displays the background image in accordance with the background image data received from the server (col. 3, lines 14-16).

Regarding claim 9:

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Luman teaches the display system according to claim 8, wherein the second terminal device displays the background image when there is a request from the first terminal device to display the background image (col. 8, line 62 to col. 9, line 5).

Regarding claim 10:

Luman teaches the display system according to claim 8, wherein the first terminal device sends first handwritten data constituting the handwritten data received by the first terminal device to the server, the server sends the first handwritten data at least to the second terminal device, and the second terminal device displays the content of the handwritten notes indicated by the first handwritten data (Fig. 2 and col. 3, lines 7-21).

Regarding claim 11:

Luman teaches the display system according to claim 10, wherein the second terminal device sends second handwritten data constituting the handwritten data received by this second terminal device to the server, the server further sends the second handwritten data at least to the first terminal device, and the first terminal device further displays the content of the handwritten notes indicated by the second handwritten data (Fig. 2 and col. 3, lines 7-21, The examiner takes into account that writing from the many tablets discussed in Luman can be sent and displayed to each other though the projector. Thus, the first tablet can send to the second tablet, which can send back to the first or a third tablet and so on (col. 8, line 62 to col. 9, line 5)).

Regarding claim 12:

Luman teaches the display system comprising a first terminal device and a second terminal device constituting terminal devices according to claim 1, wherein the first terminal device generates a synthesized image (collaborative markup projection system) including the background image and the content of the handwritten notes displayed superimposed on this background image to be sent to the second terminal device, and the second terminal device displays the synthesized image as the background image in the second terminal device (col. 3, lines 7-21, The examiner takes

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into account that since the markups can be collaborative, the image sent is thus synthesized based on additional markups coming from multiple tablets.).

Regarding claim 13, see rejection made to claim 1, as it addresses the rejection to the system of this computer program (Fig. 3 and col. 4, lines 49-60).

Regarding claim 14, see rejection made to claim 1, as it addresses the rejection to the system of this recording medium (Fig. 3 and col. 4, lines 49-60).

Regarding claim 15, see rejection made to claim 1, as it addresses the rejection to the system of this method (Fig. 3 and col. 4, lines 49-60).

Regarding claim 16, Luman teaches the terminal device according to claim 1, wherein the handwritten data is associated with time series data in accordance with the coordinates of a pen used for handwriting on the paper medium and time stamp data indicating the timing with which the pen is detected (col. 8, lines 22-36).

Regarding claim 17, Luman teaches the terminal device according to claim 16, wherein the central processing unit can reproduce the content of notes handwritten on the paper medium on the display device in chronological order in accordance with the handwritten data and the time series data (Fig. 3, col. 8, lines 22-36).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Vanchy Jr. whose telephone number is (571) 270-1193. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J. Vanchy Jr.
Examiner
AU 2609
(571) 270-1193
Michael.Vanchy@uspto.gov

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624